

REMARKS

The Examiner's Office Action mailed April 10, 2006, was received and its contents carefully reviewed. Claims 1-56 were previously presented and remain pending in the present application.

A. Previous Correspondence Regarding Restriction Requirement

Previously, on February 9, 2006, Applicants filed an Election in response to the Examiner's Restriction Requirement mailed on January 9, 2006. Applicants elected with traverse Species I, namely claims 1-26 and claims 29-35. Applicants requested reconsideration of the Examiner's Restriction Requirement with respect to Species III (claims 36-49) and Species IV (claims 50-56). As indicated in the response to the restriction requirement, full consideration and examination of elected Species I would necessarily encompass the invention of Species III and IV. Because Species III and IV can be examined together with Species I without serious burden to the Examiner, Applicants requested examination of these species as well.

B. Applicant's Election with Traverse and the Arguments Presented with Regard to the Non-Elected Species Were Not Addressed in the Office Action Mailed on April 10, 2006.

In the Office Action mailed on April 10, 2006, the Examiner did not address Applicants' Election with Traverse and the arguments presented with regard to the non-elected species. Applicants' representative telephoned the Examiner on June 19, 2006, to inquire as to the status of the non-elected species and requested a Supplemental Office Action to provide a complete written record of the prosecution. No Supplemental Office Action was provided. Applicants respectfully request that such a written record addressing Applicants' Election with traverse be provided with the Examiner's next correspondence. Alternatively, Applicants request that the Restriction Requirement be withdrawn by the Examiner.

C. Claim Rejections under 35 U.S.C. § 112

Claims 1-24, and claim 29 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that the claim language is not clear as to whether the method of capturing data for use in a catalog is indented [sic] use and doesn't carry patentable weight. Applicants are at a loss to understand this rejection because the allegedly unclear pending claims discussed by the Examiner include limitations that were recited in amendments and responses filed over the last eighteen months, the subject of which were three office actions from the Examiner. Applicants regret that such concerns were not made of record earlier in the prosecution of this case so that examination on the merits could commence. As the application presently stands, the Examiner applied no art to reject claims 1-24 allegedly due to the claim rejections under § 112.

The purported goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. MPEP § 709. Applicants respectfully request that the next communication with the Examiner include a complete Office Action, for example, addressing each of the points raised by Applicants with regard to the above-mentioned restriction requirement, additional concerns with regard to claim language, and a search of the relevant art to provide a clear record of the prosecution of the present application.

The Examiner indicates that "the claims is not clear [sic] in whether the captured information is to create, update, or be added to an existing catalog since the claims merely mentions [sic] the use of the captured information 'for use in a catalog'." See page 3 of the Office Action mailed April 10, 2006. Claim 1 recites a method of capturing data for use in a catalog comprising capturing product data and storing the captured product data. The method recited in claim 1 provides additional limitations regarding the capturing and the storing, but there is no mention of whether the captured information is to create, update, or be added to an existing catalog, and it

would be improper of the Examiner to import additional limitations regarding the creation, updating, or addition of the captured information into claim 1.

The Examiner further asserts that:

“The claims disclose [sic] system SKU, manufacturer SKU, and a customer SKU, identifying a product in and the customer SKU U [sic] is assigned by the customer, and the customer being a manufacturer, [sic] it's unclear to the examiner if the customer is the manufacturer will [sic] the customer SKU and the manufacturer SKU are the same or different, if they are the same how the previous limitation ‘manufacturer SKU associated with the product within the product data system’ can be performed and how the customer can assign the SKU if the customer is the manufacturer.”

See page 3 of the Office Action mailed April 10, 2006.

In a telephone conversation with the Examiner on June 19, 2006, Applicants' representative requested additional clarification with regard to this rejection as well as the other matters discussed above with regard to the election and below with regard to rejections made under 35 U.S.C. § 101. However, no additional clarification was received, nor was a supplemental Office Action issued to provide additional details to the written record with regard to the Examiner's rejection.

The specification is replete with examples of customers and SKU numbers related to the customers. Customers may be manufacturers, distributors, and resellers, to name a few. See lines 7-9 on page 6 of the present Specification. Further, additional details with regard to the product data is included for the Examiner's consideration in the specification at least on page 7, lines 10-15; page 21, lines 2-18; and throughout pages 24-26, and 31-33.

Continuing on page 3 of the Office Action, the Examiner again focuses on the phrase in the preamble of claim 1 “for use in a catalog” by stating:

“The other issue if the information is been [sic] captured ‘for use in a catalog’ how the customer can request customized distribution of product data for a particular product, or will the product have more than one product information depending on the

customer, because for a sue [sic] in a catalog the product should disclose all the information related to that specific product.”

With respect, the customer can request customized distribution of product data for a particular product by assigning a unique customer SKU that identifies the product, as recited in claim 1. For example, a particular product may have a system SKU that identifies the product within the product data system, a manufacturer SKU associated with the product that identifies the product within a product line of a manufacturer, and a customer SKU that identifies the product within the customer environment. A particular product such as an Eberhard Faber #2 pencil may have a system SKU assigned by Office Max, a manufacturer SKU assigned by Eberhard-Faber, and a customer SKU assigned by the U.S. Patent and Trademark Office identifying the commodity within the Patent Office supply environment.

Additionally, the Examiner asserts “On the limitation of ‘a link to product information characterizing the product’. [sic] It’s unclear to the examiner on where this link is located and how it links the product information and it link [sic] the product information to what?”

As recited in claim 1, the link to product information characterizing the product is one element included in the captured product data. The link is an attribute of the captured product data. This link is discussed at least on page 32 of the present Specification.

In the previous RCE submission filed on February 9, 2006, Applicants amended claims 1, 22, 23, and 24 to provide additional details regarding the multiple stock keeping units (SKUs) and customization of catalogs and to further describe the claimed features. Additionally, Applicants reformatted the claims for easier reading and to comply with generally accepted formatting guidelines. Support for the substantive amendments may be found throughout the specification and at least on page 7, lines 10-15; page 21, lines 2-18; and throughout pages 24-26 and 31. No new matter was introduced by these amendments.

Additionally, new claims 25-56 were added to recite additional details regarding the present invention. Support for these new claims may be found at least

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on pages 7 (claims 25-27), 13 (claim 28), 21 (claims 29-33, 36, 37, 51), 24 (claims 38-41), 25 (claims 43, 44), 26 (claims 34, 35, 45-47), 27 (claim 48), 29 (claim 49), 30 (claim 50, 55, 56), 31 (claim 42), 38 (claim 52-54), and throughout the specification.

The most-recent amendments to these claims were made after a final rejection, and the after-final amendment was not entered in the record. The same amendments and the same claims 1-24 were duplicated in the RCE submission. With respect, Applicants submit that the present claims 1-56 comply with the requirements of 35 U.S.C. § 112, second paragraph, and request reconsideration of the rejection under ~~U.S.C. § 112, second paragraph, and withdrawal of the rejection in the present~~ application.

Alternatively, Applicants respectfully request a complete Office Action providing sufficient detail with regard to the claims and/or the portions of the pending claims 1-56, which the Examiner purports fail to meet the requirements of U.S.C. § 112, second paragraph.

D. Claim Rejections under 35 U.S.C. § 101

On page 4 of the Office Action mailed April 10, 2006, the Examiner provides a short treatise regarding 35 U.S.C. § 101 and asserts:

“[T]he claimed invention is directed to non-statutory subject matter. the It is [sic] essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement.”

However, on page 6 of the Office Action mailed April 10, 2006, the Examiner asserts “No art has been applied to reject claims 1-24 due the [sic] 112 and 101 rejection at this point.” The present application was filed on July 26, 2000, and has been pending for six years. For this entire time, the application has been assigned to the same Examiner, yet the Examiner makes no effort to apply prior art references to

each of the multiple non-final and final Office Actions (totaling six Office Actions) during the initial application and the first Request for Continued Examination (RCE). Applicants respectfully request a prompt yet complete examination of their application as alluded to by the Examiner in the § 101 rejection. Under the principles of compact prosecution and in fairness to the Applicants, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement.

~~... The Examiner fails to cite which portion of which claim or claims is~~ considered to be rejected under 35 U.S.C. § 101. The only clue as to how 35 U.S.C. § 101 is being applied with regard to the present application is the cryptic assertion below, reproduced as it appears in the Office Action mailed April 10, 2006, at page 6, first through third full paragraphs:

“Although the courts have yet to define the terms useful, concrete, and tangible in the context of the practical application requirement for purposes of these guidelines, the following examples illustrate claimed inventions that have a practical application because they produce useful, concrete, and tangible result [sic]:

In the Instant application [sic]

Regarding Claims 1, 22-25, the claimed sequence of steps of data processing has no tangible results to the processed data.”

With respect, Applicants submit that the present claims 1-56 comply with the requirements of 35 U.S.C. § 101 by producing a useful, concrete, and tangible result. For example, claim 1 recites a method of capturing data for use in a catalog. The captured data is useful: it can be used to order items from a catalog. It is tangible and concrete: the captured data is stored in a product data system. With respect, there is insufficient information with which to determine the criteria the Examiner bases the rejection under 35 U.S.C. § 101. As such, Applicants request reconsideration of the rejection under U.S.C. § 101 and withdrawal of the rejection in the present application.

Alternatively, Applicants respectfully request a complete Office Action providing sufficient detail with regard to the claims and/or the portions of the pending claims 1-56, which the Examiner purports fail to meet the requirements of U.S.C. § 101.

E. Miscellaneous Claim Rejections on Pages 6 and 7 of the Office Action Mailed April 10, 2006.

On page 6 of the April 10, 2006, Office Action, the Examiner asserts "Regarding Claim 25, King discloses a method of capturing data for use in a catalog..." and goes on to list the clauses of claim 25 of the present application. It is unclear from the Office Action under what statute the Examiner is rejecting claim 25.

Similarly, with regard to dependent claim 26, the Examiner lists the additional limitation recited in claim 26 and asserts that King discloses this method, but there is no basis identified, explained, or mentioned, upon which the rejection is predicated. The rejection is improper, incomplete, and does nothing to further prosecution of this application. There is insufficient information with which to determine the criteria the Examiner bases the rejection of claims 25 and 26. As such, Applicants request reconsideration of these rejections and withdrawal of the rejections of claims 25 and 26 in the present application.

Alternatively, Applicants respectfully request a complete Office Action providing sufficient detail with regard to claims 25 and 26 and/or the portions of claims 25 and 26, which the Examiner purports fail to meet the patentability requirements.

F. Conclusion and Request for Personal Interview

Applicants request additional detail and clarification with regard to the outstanding issues in this application, namely, the election with traverse was not addressed by the Examiner in the April 10, 2006, Office Action. The rejections under 35 U.S.C. § 112, second paragraph, are unintelligible and fail to specifically point out


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the portion or portions of particular claims that the Examiner is rejecting.

Additionally, the omnibus rejection under 35 U.S.C. § 101 is improper.

The application has been pending for six years, has had the same Examiner assigned to it for that entire time, and has had at least six Office Actions issued during that time. The prosecution of this application appears to be mired in procedural issues, with inadequate and incomplete Office Actions stalling the prosecution. Applicants respectfully request a personal interview with the Examiner and Supervisory Patent Examiner to address the above issues and to work cooperatively toward furthering prosecution of this application. ~~In the interim,~~ Applicants respectfully request that the next Office Action be made non-final to address these issues and to give Applicants the full benefit of a complete prosecution of this application under the patent laws.

Respectfully submitted,


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